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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,660	03/28/2001	Atsushi Tomita	032360-011	2513
7590	03/27/2006		EXAMINER	
Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			CHANKONG, DOHM	
		ART UNIT	PAPER NUMBER	2152

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/818,660	TOMITA, ATSUSHI
Examiner	Art Unit	
Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 January 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

- 1> This action is in response to Applicant's arguments. Claims 1-20 are presented for further examination.
- 2> This is a final rejection.

### *Response to Arguments*

- 3> Applicant's arguments filed 1.6.2006 have been fully considered but they are not persuasive.

#### Applicant's remarks

First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

- 4> In regards to claims 1-3, 6, 9-13 and 17-20, Applicant concludes that the Smith reference merely discloses: (a) configuring a peripheral and does not teach transmitting connection check data; (b) merely discloses initializing a peripheral but does not teach that the peripheral is newly installed and the connection thereof must be checked; and (c) monitoring a peripheral using email and does not teach transmitting connection check data in advance.

#### Applicant's remarks, pgs. 13-14.

In regards to (a), Applicant's specification describes connection check data as: "a

display command...and initial setting data or the like". Applicant's specification, pg. 39, lines 6-10. Smith discloses transmitting initial configuration data to the device [column 7 «line 15» to column 8 «line 46»]. Thus, Smith discloses transmitting connection check data as claimed.

In regards to (b), Applicant's assertion that there is no teaching of checking the connection of the newly installed peripheral is not supported by the claim. The claims merely are directed towards transmitting "connection check data" to the peripheral. As discussed above however, Applicant describes connection check data as initial setting data for the peripheral. The claims do not require that the connection of the device be checked based on the connection check data. Simply put, transmitting "connection check data" does not necessitate the functionality of checking the connection of the newly installed device. Further, Applicant's assertion that Smith does not teach that the peripheral is newly installed is also not persuasive. As admitted by Applicant, Smith discloses initializing a peripheral. One of ordinary skill in the art would understand that initializing a peripheral implies that the peripheral has been newly installed. In addition, Smith discloses "coordinating automatic installation" of printers [column 10 «lines 23-24»]. This disclosure coupled with what would have been known to one of ordinary skill in the art clearly suggests that the printer peripherals are newly installed before they are initialized by Smith's process.

In regards to (c), this limitation was disclosed by the combination of Smith and L'Heureux. See remarks below.

5>      Applicant then discusses L'Heureux. L'Heureux was cited the Office to teach transmitting connection check data in advance of installing the peripherals. L'Heureux

discloses utilizing email messages to configure devices [figures 6 and 7]. As one of ordinary skill in the art would understand, email messages may be transmitted at any time regardless of whether a not a user is online to receive it. The email message is stored, until ready to download by the user at the device [column 3 «lines 30-31»].

The combination of Smith, L'Heureux and what would have been known to one of ordinary skill in the art would produce a system whereby initialization or configuration is embedded within an email message, the email message being sent before the user (or device) is online or installed, whereby when the device has been installed, receives the email message along with the initialization information.

6> With respect to claims 7-8 and 14-16, Applicant discusses the Motoyama references and the Applicant's Admitted Prior art ["AAPA"] individually. As pointed out by Applicant, Motoyama teaches determining which of two communications systems are needed.

In combination with Smith and L'Heureux, Motoyama teaches a system whereby the connection check data as taught by Smith and L'Heureux is transmitted over one of two communications systems whereby one of the systems is a public telephone circuit.

Further, as discussed in the Office Action, AAPA teaches a controller waiting for a reception of initial transmission data transmitted from the newly installed apparatus to make sure that the apparatus is available, before transmitting the connection data.

Thus, the combination of the references with AAPA produces the limitations as claimed of claims 7 and 8.

7> Claim 14 did not teach or further define over the previously discussed limitations of claims 1, 7 and 8 and are therefore rejected for at least the same reasons.

8> In regards to the rejection of claims 1-6, 9, 11-13 and 17-20 over Kraslavsky and L'Heureux, Applicant's arguments are not persuasive. Applicant asserts that Kraslavsky does not disclose transmitting connection check data in advance of installing a new equipment apparatus. Applicant's remarks, pgs. 24-25. However, Kraslavsky discloses that a configuration data that may transmitted to a peripheral such as a printer includes "initial environment" which suggests that the configuration data is transmitted to a newly installed printer that requires the initial environment to start up [column 20 «lines 23-38»]. As discussed above, L'Heureux discloses utilizing an email mechanism to transmit necessary information to devices before the devices can receive the information [column 3 «lines 30-31»]. The combination of Kraslavsky and L'Heureux discloses a system whereby initial configuration (connection check data) may be emailed to a printer before the printer is installed.

9> Applicant's remarks in regards to Motoyama and AAPA were discussed above.

Conclusion

10> For the foregoing reasons, Applicant's arguments are not persuasive and all claim rejections set forth in the previous Office Action, filed 10.11.2005 are maintained:

- a. Claims 1-3, 6, 9-13 and 17-20 remain rejected under 35 U.S.C § 103(a) as being unpatentable over Smith et al, U.S Patent No. 6.785.015 ["Smith"] in view of L'Heureux et al, U.S Patent No. 6.697.942 ["L'Heureux"].
- b. Claims 4 and 5 remain rejected under 35 U.S.C § 103(a) as being unpatentable over Smith and L'Heureux, in further view of Frantz, U.S Patent No. 6.003.070.
- c. Claims 7-8 and 14-16 remain rejected under 35 U.S.C § 103(a) as being unpatentable over Smith and L'Heureux, in further view of Motoyama et al, U.S Patent No. 6.581.092 ["Motoyama"] and Applicant's admitted prior art ["AAPA"].
- d. Claims 1-6, 9, 11-13 and 17-20 remain rejected under 35 U.S.C § 103(a) as being unpatentable over Kraslavsky et al, U.S Patent No. 5.537.626 ["Kraslavsky"] in view of L'Heureux et al.
- e. Claims 7-8 and 14-16 remain rejected under 35 U.S.C § 103(a) as being unpatentable over Kraslavsky and L'Heureux, in further view of Motoyama and Applicant's admitted prior art ["AAPA"].

*Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:00 AM to 5:00 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER